

### **REMARKS**

Addressing first the species election, several comments are warranted:

Firstly, the Examiner apparently has not identified the statements of invention appearing in the specification from page 2, line 21 to page 3, line 15 as defining any particular species. The claims which correspond to these statements of invention are considered to be generic. The statements of invention which appear in the specification from page 2, line 21 to page 3, line 15 correspond to Claims 1 to 5 and to Claims 18 to 21.

Secondly, the claims which correspond to the statements of invention at page 3, line 16 to line 26, which have been identified by the Examiner as species 1, are Claims 6 to 10 and 22 to 25.

Thirdly, since the Examiner does not appear to have included the statement of invention at page 3, lines 28 and 29 as being one of the five species, Applicant assumes it to be generic or, alternatively, the Examiner has made an error and the statement of invention which appears at page 3, lines 28 and 29 should have been included in species 1. This statement of invention corresponds with Claims 11 and 26.

Fourthly, it appears that in identifying the statements of invention at page 4, line 8 to line 25 in species 3, the Examiner has made an error. Species 3 should only include the statements of invention at page 4, line 2 to line 7. Including the statement of invention at page 4, line 8 to line 25 in species 3 makes no sense to Applicant. Claim 17 corresponds with the statement of invention at page 4, line 8 to line 25.

Turning now to the restriction requirement, the Examiner appears to be having considerable difficulty in understanding the English language. Applicant sympathizes. However, respectfully, a proper grasp of the English language would lead one to understand that the method of Claim 33 is not patentably distinct from the product of Claim 1; neither is the

method of Claim 33 patentably distinct from the product of Claim 17. To conclude otherwise required that the claim language be treated inconsistently. A limitation should be given a consistent interpretation.

Claim 1 claims an inductor coil on the semiconductor chip, and a MAGFET which is also located on the semiconductor chip. The method of Claim 33 requires the fabrication of an inductor coil on the semiconductor chip, and the fabrication of a MAGFET on the semiconductor chip. Thus, there can be no patentable distinction between the product of Claim 1 and the method of Claim 33. As discussed in Applicant's response of September 8, both Claim 1 and Claim 33 cover the conditions where the MAGFET can be formed above or below the inductor coil. The Examiner draws a distinction between "on" the chip and "in" the chip, which distinction is inconsistent with the claims and the specification. The Examiner states, "the product as claimed can be made by another and materially different process such as one in which the inductor coil is embedded in the semiconductor chip instead of on the chip" (emphasis added). However, the language of both claims clearly calls for the inductor to be formed "on", not "in", the chip. So claim 33 covers a method where the inductor coil is embedded in the semiconductor chip, and claim 1, having comparable scope as a product, covers the structure so made. If the inductor coil were formed before the MAGFET, the MAGFET would then be formed on top of the inductor coil, and clearly the inductor coil would be embedded in the chip. This arrangement is clearly disclosed and covered by both claims 1 and 33. Similarly, if the MAGFET is formed before the inductor coil, then the MAGFET would be embedded in the chip. Indeed, Claims 1 and 33 are not limited to only one of the MAGFET and inductor coil being embedded in the chip, since neither Claim 1 nor Claim 33 limit the components which can be formed on the chip. Thus, further components could be formed on top of the MAGFET or the inductor coil, depending on which was above the other. If other components were formed on the chip on top of the MAGFET and the inductor coil, then both the MAGFET and the inductor coil would be viewed as being embedded in the chip. Thus "on" must be given a consistent interpretation in claims 1 and 33, rendering the Examiner's postulated independence an unsupportable - and incorrect - conjecture.

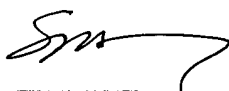
Thus, Applicant is having considerable difficulty understanding how the Examiner can contend that the inductor coil could be embedded in the semiconductor chip and not at the same time be on the semiconductor chip. That is, Applicant disagrees with the suggestion that two different methods would be involved. Surely if the inductor coil is not *on* the chip, it would have to be *off* the chip; and if it were off the chip, it is beyond the bounds of comprehension of the Applicant as to how it could at the same time be embedded in the chip. Thus, the Examiner is inconsistent in his analysis. A consistent analysis leads to the conclusion that the method of claim 33 is neither independent nor distinct from the product of claim 1. The method of claim 33 defines the only method known to Applicant to make the product of claim 1.

Based on the foregoing, if the restriction requirement is rescinded but the species election is maintained, method claims 38 to 41 should be included in species 1. Likewise, claims 34 to 37 and claim 42 should be included in species 1 for the same reasons that claims 2 to 5 and 11 of the product claims should be included.

Finally, the statement of invention from page 4, line 29 to page 5, line 15, which corresponds to the independent method claim 33, is of similar scope to that of claim 1 and should not be seen to define a different specie.

Applicant therefore requests reconsideration, withdrawal of the restriction requirement between claims 1 and 33, and further action consistent with these remarks.

Respectfully submitted,



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